

### REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

#### Listing of Claims

The Examiner's request that all of claims 1-13 be identified as "(Previously presented)" has been noted. However, of claims 1-13 only claims 7-13 were involved in the renumbering in question. Claims 4-6 have not been renumbered or amended. Accordingly, it is deemed appropriate that these claims remain designated as (Original) unless the Examiner can provide reason why this should not be done. Besides, not maintaining this designation is apt to have this response being rejected and returned as being non-compliant prior to actually reaching the Examiner.

#### Rejections under 35 USC 112

In connection with claims 1 and 8, the term "storage facilities" is asserted to be indefinite "because it is not made explicitly clear if the term refers to the library (Fig. 1, 7) or the shared memory (Fig. 1, 9 and 11) or both or neither." The Applicant is puzzled by this position and the position taken at the top of page 7, wherein it is stated that a "library is more abstract and not necessarily the same as a storage facility which is more tangible." This has nothing to do with the clarity of the claim and seemingly pertains more to what range of disclosed elements that the claim can be considered to read on. There is no mention of any lack of support for the claim language – noting that the rejection seems to be taking issue with the disclosure rather than the claim language.

The issue is whether a person of skill in the art could read the claim and understand what is meant by the term "storage facilities" and what it encompasses. This is the yardstick for this determination, and reference to the disclosure and drawings to determine if the term is clear and distinct and readily understandable by the claim reader.

## MPEP 2173.01 Claim Terminology

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

In this instance it is not even the context in which the term “storage facilities” is used that is at issue. The Examiner has made it clear that it is the “term” per se that is deemed indefinite. Claims are intended to define the scope of the invention not describe the embodiments thereof. It is respectfully submitted that there is a fundamental flaw in the Examiner’s position.

For example, in connection with the rejection of the term “allowed work unit rate” it seems that the Examiner is demanding an “explanation” of what goes on and what the rate is per se. Again it seems that the Examiner is under the misconception that a claim should be in effect the disclosure and at the very least nothing less than a picture claim.

A further problem becomes evident with the rejection based on the position that “there is no structural relationship between the ‘storage facilities that do not rely on the functioning of the processes’.” The issue with the nexus between elements would seem as if the claims are being treated as apparatus claims. Further, the absence of reliance on the functioning of the process is clearly disclosed – note MPEP 2173.01 quoted *supra*. The nexus of the recited “storage facilities” with the steps of the claimed method is clear in the third paragraph of claim 1, for example.

Claim breadth is not synonymous with indefiniteness.

**MPEP 2173.04 Breadth Is Not Indefiniteness**

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention as evidenced by statements outside of the application as filed, a rejection under 35 U.S.C. 112, second paragraph, would be appropriate. If the claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection under 35 U.S.C. 112, first paragraph, would be appropriate. If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.

In connection with claims 1 and 8 it is again asserted that the "allowed work unit rate" is indefinite because it is not made explicitly clear in the claim language that this "allowed work unit rate allows for and it is not clear what the rate consists of.

On page 7 of this Office Action it is suggested that the claims be amended to clarify this issue. However, the claims as they stand are clear and any amendment would invite a shortcut to an advisory action. The Examiner seems to miss the fact that the claims as it currently stands reads:

communicating, at an allowed work unit rate for the resource, between the at least one process and the licence controller by storing at least one parameter in the storage facilities provided by the inter-process communication;

The commas (,) on either side of “at an allowed work unit rate for the resource” seem to have been overlooked. This would seem to be the only possible explanation for the statement that “ it is not clear if the at least one parameter is the allowed work rate unit or if the parameter is used to determine the work unit rate.”

This above quoted claim language if rephrased indicates that communication between the at least one process and the license controller is carried out at an allowed work unit rate and the communication is such as to store at least one parameter in the storage facilities provided by the inter-process communications.

The introduction of the word “at” has not been noted in the rejections – see paragraph #3 line 6, for example.

#### Rejections under 35 USC § 103

The rejection of the claims 1-13 as being unpatentable over Freeman et al. in view of Chintalapati et al. is respectfully traversed.

It is well established that in order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

In this rejection it is admitted that Freeman et al. fail to explicitly teach having an inter-process communication mechanism and turns to Chintalapati et al. to compensate for this acknowledged shortcoming.

The disclosure of Chintalapati et al. that is relied on to suggest the transfer of an inter-process communication mechanism to Freeman et al., is drawn from a part of the first claim of this patent. Inasmuch as the courts have long held that claims are for claiming and the disclosure is for disclosure – the question therefore arises as to what

part of this claim contains disclosure that engenders the motivation that is alleged to flow therefrom? This of course must be resolved before any tenability to the rejection can be established.

Indeed, if a portion of this claim can be relied upon there must be some written disclosure which would be reasonably expected to expand on the claimed subject matter and provide support for the same. The reason this is not presented in this rejection is not understood – why rely on claims as different from disclosure to make a major part of one’s case – especially when motivation is critically missing?

This notwithstanding this shortcoming, the rejection goes on to assert that it would have been obvious at the time of invention to include “dynamically controlling resources based on parameters with inter-process communication to the existing system of Freeman et al. because it would “increase the efficiency of control operations and improve the performance of computer systems by reducing the amount of time that services to resources are unavailable because of administrative functions.” Column 2, lines 39-41 and 57-63 are quoted in support of this position.

However, this is mere conjecture. Lines 57-63 of column 2 of Chintalapati et al. disclose:

It would be advantageous to provide **a method, apparatus and program product that allow administration of a daemon program** without requiring that the daemon program be **completely disabled** during the administration process. Such an invention improves the performance of computer systems by reducing the amount of time that services to resources are unavailable because of administrative functions. (Emphasis added)

Chintalapati et al. then states that:

The present invention improves the **administration of daemon programs** by providing a **mechanism to perform administrative functions on the daemon programs**

without terminating the services provided by the daemon programs to the serviced resources. (Emphasis added)

It is therefore clear that the system to which the teachings of Chintalapati et al. are to be transferred would have to include a daemon program so that it could be improved with the teachings of Chintalapati et al. However, it has not been established that Freeman et al. has any such program to improve. It further has not been established that a daemon program could be transferred to a system such as disclosed in Freeman et al. with any advantage. In that the burden is on the Examiner to make this case and not just cite disclosure of this, disclosure of that, and hope that things will fall into place.

The disclosure which is relied upon for rejection clearly teaches that daemon programs require an administrator for efficient operation and even then suffer from drawbacks to services for resources which are provided by the daemon programs. This does not sound like something that would suggest that daemon programs should be considered for use in Freeman et al. "because it would increase the efficiency of control operations and improve the performance of computer systems by reducing the amount of time that services to resources are unavailable because of administrative functions."

The rejection has further failed to establish that the system disclosed in Freeman et al. could be reasonably expected to suffer from administrative shortcomings that waste time and would benefit from the improved daemon program administration. It is mere conjecture that the purportedly obvious transfer of teachings would in fact be considered.

It is submitted that a patentable invention, within ambit of 35 USC 103, may result even if inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond results inherent in their use. As made clear in *In re Spinnoble*, (CCPA) 160 USPQ 237 (1969), it is proper to inquire as to the reasons for making the combination inasmuch as a patentable invention may lie in the discovery of the source of problem even though its remedy may appear obvious once source of problem is identified. This is part of the "subject matter as a whole" analysis which should always be made in determining the obviousness of an invention under § 103. Of course, in making this analysis, special care must be exercised to

avoid reading obviousness into the claimed invention on the basis of applicant's own statements. More specifically, the prior art must be considered without reading the applicant's teachings into that art, and to ensure that the teachings of prior art would, in and of themselves and without benefits of applicant's disclosure, make the invention(s) as a whole, obvious.

It is submitted that the rejection does not establish a reason for the hypothetical person of ordinary skill to consider introducing a daemon program into the system of Freeman et al. let alone an improved form of daemon program. The only motivation for combination that is found comes from the applicants disclosure and claims.

There are three possible sources for a motivation to combine references: 1) the nature of the problem to be solved, 2) the teachings of the prior art, and 3) the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) Further, even if a combination of references may teach every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obvious must be held improper. It also should be noted that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

A further shortcoming resides in that claim 1 calls for a method for controlling the use of a resource by at least one process in a data processing system having an inter-process communication mechanism provided with storage facilities. It has not been established how the inter-process communication mechanism for which Chintalapati et al. is relied on, is "provided with" the storage facilities purported to be found in the Freeman et al. system. Indeed, the rejection seems to improperly rely on the memory used in Chintalapati et al. instead of that which is cited as being found in Freeman.

Further, claim 1 calls for communicating between at least one process and the licence controller by storing at least one parameter in the storage facilities provided by the inter-process communication, and controlling the use of the resource by the process according to the parameter.

The rejection has still not identified which parameter, if any, is stored in the storage facilities and how this parameter is used in connection with the control of the

resources. In this Office Action, the Examiner has, at the bottom of page 8, merely referred to claim 1 of Chintalapati et al. as disclosing a “parameter” and continues to fail to establish which parameter the hypothetical person of ordinary skill would consider in this instance. This arbitrary indication that claim 1 of the Chintalapati et al. reference discloses a “parameter” simply fails to meet the Examiner’s burden of establishing a *prima facie* case.

Indeed, claim 1 of Chintalapati et al. sets forth:

1. A computer controlled method for dynamically performing a control operation on a daemon program that provides a service for two or more resources, the method comprising:
  - (a) registering the daemon program with an inter-process communications mechanism, and using the inter-process communication-mechanism to connect the daemon program to a service agent program which interfaces with one or more client programs or command line interfaces from which a request for a control operation initiates;
  - (b) sending a message including the request for the control operation from the service agent program to the daemon program using the inter-process communication mechanism; and
  - (c) causing the daemon program to communicate with a preferences **mechanism which contains at least one parameter** for each of a first resource and a second resource associated with the daemon program, and implement, in response to the request for a control operation, **at least one new parameter or a change of at least one parameter in the preferences mechanism** used by the daemon program to serve a selected one of the first resource and the second resource, wherein termination of the daemon program is not required to serve the selected one of the first and the second



resource according to the new or changed parameter; and wherein interruption of a service being performed concurrently for the other of the first resource and the second resource is not required. (Emphasis added)

Just where and how this "disclosure" suggests that this parameter is in fact storable in the storage facilities which are alleged to be provided by the Freeman et al. reference, is simply not understood and has not been established in this rejection to the degree necessary that a *prima facie* case of obviousness can be established.

Accordingly, unless this issue can be resolved the rejection must be deemed untenable.

It is submitted that for at least the above stated reasons, the rejections are not tenable and should be withdrawn.

Conclusion

It is respectfully submitted that a *prima facie* case of obviousness has not been established for at least the above stated reasons. Favorable reconsideration and allowance of this application is courteously solicited.

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